



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

GEORGE A. HERBSTER  
100 CUMMINGS CENTER  
SUITE 213-C  
BEVERLY MA 01915

**MAILED**

**JAN 11 2011**

**OFFICE OF PETITIONS**

In re Patent No. 5,835,680	:	
Issue Date: 11/10/1998	:	DECISION ON PETITION
Application No. 08/726,636	:	
Filed: 10/07/1996	:	
Attorney Docket No. A85-057	:	

This is a decision in response to the petition under 37 CFR 1.378(b), filed August 6, 2010, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is **dismissed**.

If reconsideration of this decision is desired, a "Petition for Reconsideration under 37 CFR 1.378(e)" must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertake any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued on November 10, 1998. The second maintenance fee could have been paid during the period from November 10, 2005 through May 10, 2006, or with a surcharge during the period from May 11, 2006 through Monday, November 13, 2006. Accordingly, this patent expired on November 11, 2006, for failure to timely remit the maintenance fee.

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks requirement (3).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the

maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987).

Petitioner asserts that he retained the services of the Sofer Firm to docket and track the maintenance fee due dates for this patent as evidenced by the firm's payment of the first maintenance fee. Petitioner contends that the delay in paying the second maintenance was unavoidable because the Sofer Firm failed to inform petitioner of the need to pay the maintenance fee. Further, petitioner asserts that many of petitioner's records that may have contained information to support petitioner's assertion were destroyed in a fire on July 4, 2006.

While petitioner allegedly chose to rely upon the Sofer Firm, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 USC 41(c). See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether counsel at the Sofer Firm acted reasonably and prudently. Id. Nevertheless, petitioner is bound by any errors that may have been committed by his legal representative. California, supra. As such, assuming that the Sofer Firm had been so engaged, then it is incumbent upon petitioner to demonstrate, via a documented showing, that counsel at the Sofer Firm had docketed this patent for the second maintenance fee payment in a reliable tracking system. Id. If petitioner cannot establish that the Sofer Firm was contracted to pay the maintenance fee and docketed the maintenance fee, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee. Id.

The Office notes that petitioner did not submit any statements or docketing records from the Sofer Firm showing that the second maintenance fee was docketed and explaining the cause of the delay in timely payment of such maintenance fee. Petitioner did not show that he provided any money to his attorney to cover the amount due for the maintenance fee, any surcharges, and the attorney's services. Moreover, the record does not show that petitioner monitored the performance of Sofer firm pursuant to petitioner's belief that the firm would pay the maintenance fee. Petitioner failed to demonstrate it

diligently inquired with the law firm or the USPTO into the status of the patent and maintenance fee payment. Additionally, petitioner did not explain what steps petitioner took to restore any lost information regarding this patent after his records and files were destroyed on July 4, 2006. Petitioner's inaction does not reflect the due care and diligence exercised by a prudent and careful person with respect to his or her most important business, and as such, does not demonstrate unavoidable delay. Rather, a prudent person would have taken actions to ensure that the services of Sofer Firm were timely performed as specified.

The Office reminds petitioner that he is bound by the consequences of the actions or inactions of his duly authorized and voluntarily chosen representative. Therefore, any delay caused by the negligence or mistakes of petitioner's voluntarily chosen legal representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. at 317; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). Furthermore, merely engaging another to pay the maintenance fees does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. That is, the burden remains on the patent owner to track the due dates and make certain that the maintenance fees are paid in a timely manner.

As to petitioner's argument that he did not receive any notices from the USPTO, the Office reminds petitioner that under the statutes and regulations, the USPTO has no duty to notify a patent owner of the requirement to pay maintenance fees or to notify the patentee when the maintenance fee is due. Although the Office may mail maintenance fee reminders strictly as a courtesy, it is solely the responsibility of the patent owner to ensure that the maintenance fee is paid timely to prevent expiration of the patent.

In summary, the record fails to disclose that petitioner took reasonable steps to ensure timely payment of the maintenance fee. Furthermore, petitioner did not provide sufficient documentary evidence in support of his assertion of unavoidable delay. Accordingly, the petition under 37 CFR 1.378(b) is **dismissed**.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fee and post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable

Any request for refund should be in writing to the following address:

Mail Stop 16  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                Mail Stop Petition  
                          Commissioner for Patents  
                          P.O. Box 1450  
                          Alexandria, VA 22313-1450

By FAX:                (571) 273-8300  
                          Attn: Office of Petitions

By hand:              Customer Services Window  
                          Randolph Building  
                          401 Dulany Street  
                          Alexandria, VA 22314

Correspondence may also be submitted electronically via EFS-Web.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions